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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN GOLD and ROBERT GIBSON

Appeal 2009-011820
Application 10/684,001
Technology Center 2100

Before LANCE LEONARD BARRY, HOWARD B. BLANKENSHIP, and
JAMES R. HUGHES, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1, 3-10, 12-19, and 21-25, which are all the claims remaining in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm, but designate our decision as new grounds of rejection under 37 C.F.R. § 41.50(b).

Invention

Appellants' invention relates to calculating the number of scratch media needed for future backups using backup job information obtained from backup applications. Abstract.

Representative Claim

1. A method comprising:

obtaining information regarding a future backup from one or more backup applications for a plurality of backup jobs;

calculating a projected number of media for a future execution of at least one of the backup jobs using the information regarding the future backup, said calculating also comprising dividing an average historical backup size of the backup job by an average capacity of a media type associated with the backup job; and

presenting the projected number of media to a user.

Examiner's Rejections

Claims 1, 17, and 23 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claim 12 of co-pending Application No. 10/684,207.

Claims 1, 3-5, 8-10, 12-19, and 21-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bolin (US 5,664,146) and Kanai (US 2002/0152181 A1).

Claims 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bolin, Kanai, and Carlson (US 2004/0044862 A1).

ANALYSIS

I. Provisional Obviousness-Type Double Patenting Rejection

Appellants do not address the provisional double patenting rejection set forth in the Final Rejection and the Answer. Accordingly, we summarily sustain the Examiner's provisional rejection of claims 1, 17, and 23 over claim 12 of co-pending Application No. 10/684,207 under the judicially created doctrine of obviousness-type double patenting. *See* Manual of Patent Examining Procedure (MPEP) § 1205.02, 8th ed., Rev. 8, July 2010 ("If a ground of rejection stated by the examiner is not addressed in the appellant's brief, that ground of rejection will be summarily sustained by the Board.").

II. Prior Art Rejections

Appellants argue claim 1 as representative of the claims, except for claim 15 (representative of claims 15 and 21), which is argued separately. Accordingly, we will decide the appeal with respect to the rejections over the prior art on the basis of claims 1 and 15. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Claim 1 requires obtaining "information" (i.e., data), calculating a number using the data, where calculating the number includes dividing a number by another number, and presenting the calculated number to a user. What the data are deemed to represent are not entitled to weight in the patentability analysis. *See Ex parte Nehls*, 88 USPQ2d 1883, 1887-90 (BPAI 2008) (precedential) (discussing non-functional descriptive material).

Moreover, claim 1 is not limited to any kind of machine implementation but could be performed in the human mind, with a final step

of writing, speaking, or signing the calculated number.¹ The final step is thus similar to the “informing” step in *King Pharmaceuticals, Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1274-79 (Fed. Cir. 2010). In *King Pharmaceuticals*, the subject matter of dependent claim 21, which recited “informing” the patient that the drug administered in accordance with base claim 1 had certain therapeutic effects, was subject to the rationale of “printed matter” cases even though the claims were cast as a method. The content of the “informing” was thus not given patentable weight. *See id.*

Other of the claims on appeal may require machine implementation. Claim 17, for example, recites a “system” comprised of two “computer” systems and a “user interface.” However, what the data are to represent to the human mind does not modify the underlying structure or function of the two computer systems and the user interface. As such, the names of the data in the machine implementation of claim 17 also represent non-functional descriptive material, not entitled to patentable weight. Similarly, even if instant claim 1 were to be read as requiring a computer for implementation of the claimed steps, the data names would not be given patentable weight when comparing the claimed subject matter to the prior art.

Claim 15, which depends from claim 1, recites “further comprising receiving from the user a list of one or more media to be used.” The informational content of the data -- “a list of one or more media to be used” - is not entitled to patentable weight, whether conveyed by human speech, human writing, or human input at a computer interface.

¹ In the event of further prosecution of claims of the present scope, the Examiner should reconsider whether the claims are directed to patent eligible subject matter under 35 U.S.C. § 101.

We have considered all of Appellants' arguments in defense of representative claims 1 and 15 but find them unavailing, in view of the breadth of the claimed subject matter. The claims require at most prior art reception or entry of data and calculation of a number by division of two other numbers, with presentation or display of the resulting number. We therefore are not persuaded that the claims have been rejected in error. However, because our interpretation of the actual claim requirements differs to a great degree from the Examiner's apparent interpretation of the terms, we designate our affirmance of the § 103(a) rejections as new grounds of rejection.

DECISION

The provisional rejection of claims 1, 17, and 23 under the judicially created doctrine of obviousness-type double patenting is affirmed.

The Examiner's rejections of claims 1, 3-10, 12-19, and 21-25 under 35 U.S.C. § 103(a) are affirmed in what we designate as new grounds of rejection.

With respect to the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides that "Appellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the Examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED -- 37 C.F.R. § 41.50(b)

Appeal 2009-011820
Application 10/684,001

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